

 Oct. 7, 2010  
Marilyn R. Khorsandi

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Daniel F. Williams, et al.  
Patent No. : 7,774,284  
Application No. : 09/820,377  
Filed : March 27, 2001  
Title : Apparatus, Systems and Methods For Online,  
Multi-Parcel, Multi-Carrier, Multi-Service  
Enterprise Parcel Shipping Management  
Grp./Div. : 3629  
Examiner : Plucinski, Jamisue A.  
Docket No. : PSTM0041/MRK

STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT  
IN SUPPORT OF APPLICATION FOR RECONSIDERATION OF PATENT TERM  
ADJUSTMENT INDICATED IN PATENT  
UNDER 37 C.F.R. §1.705(d)

Commissioner for Patents (Filed Electronically)  
P.O. Box 1450  
Alexandria, VA 22313-1450

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Pasadena, CA 91101  
October 7, 2010

Commissioner:

This Statement of the Correct Patent Term Adjustment ("PTA") is filed in support of a concurrently-filed Application for Reconsideration of Patent Term Adjustment.

The above-identified Patent issued on August 10, 2010, indicating a PTA of 1912 days. However, for the reasons given further below, it is respectfully asserted that the PTA determination of 1912 days is incorrect, and that the correct PTA is 1886 days. In particular, it is respectfully asserted that the determination of 1912 days is in error, due to a failure in the PAIR system Patent Term Adjustment History to provide the following Patent Term Adjustment events and/or considerations under 37 C.F.R. §§ 1.703 and 1.704, as follows:

**1. PAIR FAILED TO CALCULATE A PTA DEBIT OF TWO (2) DAYS CORRESPONDING TO A DELAY IN FILING A RESPONSE TO A NOTICE OF MISSING PARTS.**

A copy of a printout of the PAIR system Patent Term Adjustment History for the Application is attached hereto as Exhibit A. A copy of a printout of the PAIR system Image File Wrapper for the Application is attached hereto as Exhibit B. It

is respectfully submitted that the PAIR system failed to associate a Notice of Missing Parts and a corresponding Response to Notice of Missing Parts, and therefore failed to calculate a period of time under 37 C.F.R. §1.704(b), as follows:

a.) the PAIR system did not identify as a Notice of Missing Parts, the PAIR system Patent Term Adjustment entry No. 4, dated 05-08-2001, entitled "Notice Mailed--Application Incomplete--Filing Date Assigned" (see Exhibit A hereto; see also, Exhibit B hereto – PAIR System Image File Wrapper entry dated 05-08-2001, entitled "Pre-Exam Formalities Notice");

b.) there is no entry in the PAIR system Patent Term Adjustment History (see Exhibit A hereto) of a Response to Notice of Missing Parts, designated in the PAIR System Image File Wrapper (see Exhibit B hereto) for the Application as an entry dated "04-05-2001", entitled "Applicant Response to Pre-Exam Formalities Notice"; and

c.) the PAIR system Patent Term Adjustment History fails to associate the April 5, 2001-dated entry for Applicant's Response to Notice of Missing Parts with the Notice of Missing Parts, dated 08-10-2001.

According to 37 C.F.R. §1.704(b), it is respectfully asserted that period of adjustment credits should be reduced for the period of time "in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, . . . beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication . . . and ending on the date the reply is filed." 37 C.F.R. §1.704(b). For the present case, it is respectfully asserted that period of adjustment credits should be reduced, according to 37 C.F.R. §1.704(b), by 2 days, wherein the 2 days began on August 9, 2001 (the day after the August 8, 2001 date that is three months after the May 8, 2001 mailing date of the Notice of Missing Parts), and ended on

August 10, 2001 (the date noted in the PAIR system as the receipt date of the Response to the Notice of Missing Parts).

**2. PAIR FAILED TO CALCULATE A PTA DEBIT OF FORTY-NINE (49) DAYS CORRESPONDING TO FILING A NON-COMPLIANT APPEAL BRIEF.**

It is respectfully submitted that the PAIR system failed to associate a Notice of Defective Appeal Brief and a PAIR indication of a Defective/Incomplete Appeal Brief Filed with a corresponding Response to the Notice of Defective Appeal Brief, and therefore failed to calculate a period of time under 37 C.F.R.

§1.704(c)(7), as follows:

a.) the PAIR system identifies as a Defective or Incomplete Appeal Brief the Appeal Brief filed on 10-30-2006. See the PAIR system Patent Term Adjustment History entry dated 10-30-2006, entitled "Defective/Incomplete Appeal Brief Filed" (see entry Number 49.1 on Exhibit A hereto);

b.) there is a PAIR system entry, dated 11-14-2006, entitled "Notice – Defective Appeal Brief" (see entry Number 52 on Exhibit A hereto) and a subsequent entry dated 12-18-2006 entitled "Appeal Brief Filed" (see entry Number 53 on Exhibit A hereto); and

c.) the PAIR system Patent Term Adjustment History fails to associate the December 18, 2006-dated entry for Applicant's Appeal Brief Response to the 11-14-2006-dated "Notice – Defective Appeal Brief" with the 10-30-2006-dated entry entitled "Defective/Incomplete Appeal Brief Filed".

According to 37 C.F.R. §1.704(c)(7), it is respectfully asserted that period of adjustment credits should be reduced for the period of time "beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed." 37 C.F.R. §1.704(c)(7). For the present case, it is respectfully

asserted that period of adjustment credits should be reduced, according to 37 C.F.R. §1.704(c)(7), by 49 days, beginning on October 31, 2006 (the day after the October 30, 2006 filing date of the originally-filed Appeal Brief and ending on December 18, 2006 (the date noted in the PAIR system as the receipt date of the Appeal Brief filed in Response to the "Notice – Defective Appeal Brief").

**3. PAIR FAILED TO CALCULATE A PTA CREDIT OF TWENTY-FIVE (25) DAYS CORRESPONDING TO A PTO DELAY IN ISSUING THE NOTICE OF ALLOWANCE FOLLOWING A FINAL DECISION BY THE BPAI.**

It is respectfully asserted that the PAIR system failed to provide period of adjustment credits for the period in excess of four (4) months after a final decision by the Board of Appeals and Interferences until a Notice of Allowance was issued under 37 C.F.R. §1.703(a)(5), as follows:

a.) the PAIR system Patent Term Adjustment entry No. 70 (see Exhibit A hereto), is dated 10-30-2009 and is entitled "Mail BPAI Decision on Reconsideration - Denied;"

b.) the PAIR system Patent Term Adjustment entry No. 80 (see Exhibit A hereto), is dated 03-25-2010 and is entitled "Mail Notice of Allowance;" and

c.) the PAIR system Patent Term Adjustment History (see Exhibit A hereto), does not assign any Patent Office delay to the period of time following the fourth month after the 10-30-2009 BPAI Decision until the date on which the Notice of Allowance was mailed.

According to 37 C.F.R. §1.703(a)(5), period of adjustment credits "... begin[ ] on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences ... where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of

allowance under 35 U.S.C. 151, whichever occurs first ...." 37 C.F.R. §1.703(a)(5).

It is respectfully submitted that the Appeal Decision for the present case, dated May 28, 2009, reversed the rejections of Claims 10-14; the Decision on the Request for Rehearing dated October 30, 2009 did not disturb the Appeal Decision's reversal of the rejection of Claims 10-14. Accordingly, it is respectfully submitted that, as required by 37 C.F.R. §1.703(a)(5), at least one allowable claim remained in the application following the PAIR system Patent Term Adjustment entry No. 70 (*see* Exhibit A hereto), dated 10-30-2009 and entitled "Mail BPAI Decision on Reconsideration – Denied." Therefore, it is respectfully asserted that period of adjustment credits should be increased by the twenty-five days that began on March 1, 2010, the day following the end of the fourth month following the October 30, 2009 BPAI Decision on Rehearing, and that ended on March 25, 2010, the date that the Notice of Allowance for the present case was mailed.

Accordingly, for the above given reasons, it is therefore respectfully asserted that the determination of 1912 days is in error, and that period of adjustment credits should be further reduced by an additional two (2) non-overlapping days under 37 C.F.R. §1.704(b), should be yet further reduced by an additional forty-nine (49) non-overlapping days under 37 C.F.R. §1.704(c)(7), and should be increased by an additional twenty-five (25) non-overlapping days under 37 C.F.R. §1.703(a)(5) (*e.g.*,  $1912 - 2 - 49 + 25$ ) resulting in the correct Patent Term Adjustment of 1886 days.

PATENT NOT SUBJECT TO TERMINAL DISCLAIMER.

With respect to 37 C.F.R. §1.705(b)(2)(iii), it is respectfully submitted that no terminal disclaimer was filed for the above-identified application.

Respectfully submitted,  
KHORSANDI PATENT LAW GROUP,  
A LAW CORPORATION

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Date

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